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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/748,691	12/26/2000	Mitchell R. Swartz		4269

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EXAMINER	
PALABRICA, RICARDO J	

ART UNIT	PAPER NUMBER
3641	13

DATE MAILED: 11/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AN
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFIC
WASHINGTON, DC 202
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Paper No.

Notice of Non-Compliant Amendment (37 CFR 1.121)

The amendment filed on 11/07/02 is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121, as amended on September 8, 2000 (see *65 Fed. Reg. 54603*, Sept. 8, 2000, and *1238 O.G. 7* Sept. 19, 2000). In order for the amendment to be compliant, applicant must supply the following omissions or correction in response to this notice.

THE FOLLOWING ITEMS ARE REQUIRED FOR COMPLIANCE WITH RULE 1.121 (APPLICANT NEED NOT RE-SUBMIT THE ENTIRE AMENDMENT):

☐ 1. A clean version of the replacement paragraph(s)/section(s) is required. See 37 CFR 1.121(b)(1)(ii).

☑ 2. A marked-up version of the replacement paragraph(s)/section(s) is required. See 37 CFR 1.121(b)(1)(iii).

☐ 3. A clean version of the amended claim(s) is required. See 37 CFR 1.121(c)(1)(i).

☑ 4. A marked-up version of the amended claim(s) is required. See 37 CFR 1.121(c)(1)(ii).

Explanation: _____

_____

(LIE: Please provide specific details for correction to assist the applicant. For example, "the clean version of claim 6 is missing.")

For further explanation of the amendment format required by 37 CFR 1.121, see MPEP § 714 and the USPTO website at http://www.uspto.gov/web/offices/dcom/olia/pbg/sampleaf.pdf. **A condensed version of a sample amendment format is attached.**

☐ **PRELIMINARY AMENDMENT:** Unless applicant **supplies the omission or correction** to the preliminary amendment in compliance with revised 37 CFR 1.121 noted above within ONE MONTH of the mail date of this letter, examination on the merits may commence without entry of the originally proposed preliminary amendment. This notice is not an action under 35 U.S.C. 132, and this ONE MONTH time limit is not extendable.

☑ **AMENDMENT AFTER NON-FINAL ACTION:** Since the above-mentioned reply appears to be *bona fide*, applicant is given a TIME PERIOD of ONE MONTH or THIRTY DAYS from the mailing of this notice, whichever is longer, within which to **supply the omission or correction noted above** in order **to avoid abandonment**. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

Eric W. Burns

Legal Instruments Examiner (LIE)

(Rev. 12/01)

1. The specification refers to Figures 1, 2 and 3, e.g. see page 4. However, the application file only contains Figures 1 and 2.

Correction is required, however, no new matter is permitted.

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-14, drawn to a method, classified in class 376, subclass 100.

II. Claims 15-20, drawn to an apparatus, classified in class 376, subclass 108.

The inventions are distinct, each from the other because:

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be practiced by another and materially different process such as a process wherein the two electric fields are applied simultaneously.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and because the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

3. Upon election of one of the inventions identified above as I and II, applicant is further required under 35 U.S.C. 121 to elect one of the following disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable:

A. Wherein the isotopic fuel consist of an isotope of hydrogen.

B. Wherein the isotopic fuel is an isotope of boron.

C. Wherein the isotopic fuel is an isotope of lithium.

D. Wherein the isotopic fuel is an isotope of potassium.

4. Upon election of one of the species identified above as A-D, applicant is further required under 35 U.S.C. 121 to elect one of the following disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable:

L. Wherein the material is palladium.

M. Wherein the material is titanium.

N. Wherein the material is nickel.

5. Applicant is advised that a reply to the election of species requirements, must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP §809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harvey Behrend whose telephone number is (703) 305-1831. The examiner can normally be reached on Tuesday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone, can be reached on (703) 306-4198. The fax phone number for the organization where this application or proceeding is assigned is (703) 306-4195.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Behrend/cw

November 15, 2001

HARVEY E. BEHREND
PRIMARY EXAMINER